

Serial No. 10/612,087

Attorney Docket No. 24-007

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The applicants acknowledge receipt of the initialed copy of the Form PTO-1449 which was filed on December 28, 2006.

Claims 2, 4-7, 9, and 15-23 are pending. Claims 1, 3, 8 and withdrawn claims 10-14 have been canceled. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 2, 7, 9, 15, 19, and 21-22 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent Pub. No. 2004/0053044, Moreno ("Moreno"). Claims 4-6, 16-18, 20 and 23 were rejected under 35 USC 103(a) as being unpatentable over Moreno in view of alleged mere change in shape of component. The independent claims have been amended. Support for the amendment is located in the application as filed, for example, FIG. 1e and page 15. Insofar as the rejections may be applied to the claims as amended, the rejections are respectfully traversed for reasons including the following, which are provided by way of example.

The independent claims as amended recite "wherein said adhesive sheet comprises a base material and an adhesive layer, the adhesive layer being disposed between the base material and the release sheet so that the release sheet is releasably adherent to the adhesive sheet portions."

Without conceding that Moreno discloses any feature of the present invention, Moreno is directed to an adhesive tape mainly used as a masking tape. The thick adhesive edge makes the adhesive tape useful for masking baseboard, and for masking rough surfaces (paragraphs [0006]-[0008], [0015], [0022]).

The office action asserts that Moreno discloses the invention as claimed. To the contrary, Moreno fails to teach or suggest the invention, as presently claimed, when the claims

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are considered as a whole. Moreno fails to teach or suggest, for example, "wherein said adhesive sheet comprises a base material and an adhesive layer, the adhesive layer being disposed between the base material and the release sheet so that the release sheet is releasably adherent to the adhesive sheet portions." (See, e.g., claim 2.)

In the office action, the examiner asserts that Moreno's adhesive sheet comprises a base material of a resin sheet, citing paragraph [0023]. However, paragraph [0023] merely discloses various material for the backing layer.

Furthermore, Moreno's adhesive tape is mainly used as a masking tape, so the backing layer does not have a peeling property. In a situation that the backing layer has a peeling property, when the adhesive tape is used as a masking tape and the adhesive tape is peel from an adherend, the adhesive layer is left on the adherend. Therefore, the backing layer is not a release sheet. Moreno discloses a LAB, but paragraph [0002] of Moreno discloses that a layer of pressure-sensitive adhesive is applied to one major surface of the backing layer and a layer of LAB is applied to the other major surface of the backing layer. Furthermore, Moreno's adhesive tape may include primers to increase the adhesion of adhesive layer to the backing layer (paragraph [0027]). Consequently, LAB is not a release layer which is provided between the backing layer and the adhesive layer.

On the other hand, the release sheet recited in the amended claims can have a peeling property. That is, the adhesive sheet (which comprises a base material and an adhesive layer) can be peeled from the release sheet (that is, "the release sheet is releasably adherent to the adhesive sheet portions")

Furthermore, independent claim 2 as amended recites "wherein said plurality of adhesive sheet portions are provided longitudinally and spaced lengthwise in a central portion of said release sheet." (See also claims 4, 7, 16, 17, 19 and 20.) In Moreno, to the contrary, the

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adhesive layers are provided on the backing layer of the adhesive tape (e.g., FIG. 3), but the adhesive layers are provided width-wise rather than spaced lengthwise.

With respect to claims 4-6, 16-18, 20 and 23, the examiner contends that Moreno's thicker edge portion overlaps the side edge of the adhesive sheet of the adhesive tape. It is unclear whether the adhesive sheet means the inner adhesive 20 or the adhesive sheet includes the backing 12. However, either way, the edge adhesive 18 and the inner adhesive 20 or the backing 12 contact each other, and are not spaced apart. On the other hand, according to the present claims, the protective member is spaced apart from the adhesive sheet portions, and the protective member partially overlaps the adhesive sheet when the laminate sheet is wound into a roll. This provides a further distinction of these claims from Moreno, even if modified as proposed by the examiner.

Moreno fails to teach or suggest, for example, these elements recited in independent claims 2, 4, 7, 16, 17, 19 and 20. It is respectfully submitted therefore that claims 2, 4, 7, 16, 17, 19 and 20 are patentable over Moreno.

Furthermore, to maintain the rejection under 35 USC 103(a), it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* No. 04-1350 (U.S. Apr. 30, 2007). In the present office action, the examiner merely argues that the reason to change the shape of Moreno's thicker edge member is because "it would have involved a mere change in the shape of the component." It is respectfully submitted that changing a shape merely because shapes can be changed does not constitute a reason why the shape would have been changed, as required by the Supreme Court. The examiner is required to provide a reason why the shape would have been changed. If the examiner cannot provide a reason why the shape of Moreno's

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thicker edge would have been changed as recited, the examiner must withdraw the rejection under 35 USC 103(a) of claims 4-6, 16-18, 20 and 23.

For at least these reasons, the combination of features recited in independent claims 2, 4, 7, 16, 17, 19 and 20, when interpreted as a whole, is submitted to patentably distinguish over the references of record. In addition, Moreno clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only by virtue of their dependency from the independent claims, but also because of additional features they recite in combination.

Furthermore, dependent claims 15, 22 and 23 recite that "said adhesive sheet portions have a size and form that substantially conforms to a surface of an optical disc." The office action states that claim 15 "has not been given any patentable weight because it is directed to an intended use and is not a positive limitation." It is respectfully submitted that the size and form of a structural element in a device claim constitutes a positive limitation. The examiner has not explained why the size and form would be an intended use. Indeed, it appears that there is nothing in dependent claim 15 which could be interpreted as an intended use. Accordingly, the rejection of dependent claim 15 must be withdrawn.

With regard to the rejections of claim 22 and 23, no explanation is provided where Moreno teaches or suggests anything about adhesive sheet portions having a size and form that conforms to a surface of an optical disc. Moreover, both claim 22 and its independent claim, claim 7, were rejected under 35 USC 102(e), on the basis that Moreno teaches each recited element. Claim 23 was rejected under 35 USC 103(a) although its independent claim 19 was rejected under 35 USC 102(e) in view of Moreno; this constitutes an admission by the examiner that Moreno fails to teach or suggest the limitations of claim 23. Claims 15, 22 and 23 recite the

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same limitations. Consequently, the rejection under 35 USC 103(a) constitutes an admission by the examiner that Moreno fails to teach or suggest the limitations of claims 15 and 22. In any event, there is no explanation of where Moreno teaches the limitations recited in claims 15, 22 and 23. Accordingly, the rejections of claims 15, 22 and 23 conflict and are not understood; the finality of the rejections of claims 15, 22 and 23 should be withdrawn so that applicant can be provided an opportunity to respond to a proper rejection, if any.

In addition, the examiner's rejections of claims 9, 19, 21-22 under 35 USC 102(e) and claims 16-18, 20 and 23 fail to specify with particularity where the reference teaches the recited element. "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." 37 CFR 1.104(c)(2). This the examiner has not done. Rather, for these claims, the examiner has completely omitted any discussion from the office action. The examiner therefore must withdraw the finality and specify the particular part of the reference on which he relies with respect to these claims.

The applicants respectfully submit that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited references.

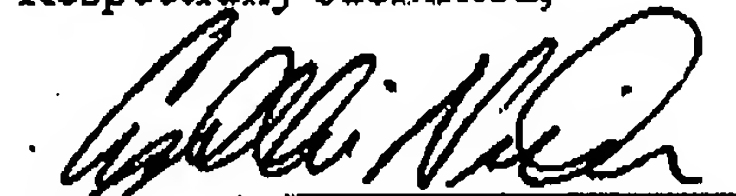
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In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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